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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,359	01/25/2001	Ichiro Fujita	1614.1118/HJS	3607
21171	7590	06/23/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,359

Applicant(s)

FUJITA, ICHIRO

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-20 have been examined.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-10 and 13-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are rejected under 35 U.S.C. 101 because these claims have no connection to the technological arts. The method claims do not specify how the claims utilize any technological arts. For example, no network or server is specified. To overcome this rejection, the Examiner recommends that the Applicant amend the claim to specify or to better clarify that the method is utilizing a medium or apparatus, etc within the technological arts. Appropriate correction is required.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The

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phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in

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affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the current application, no technological art (i.e., computer, network, server) is being utilized by claims 1-10 and 13-15. At least one step of the body of the claims must explicitly utilize the technological arts. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perkowski (6,625,581) in view of Gardenswartz (6,055,573).

Claim 1, 2, 11, 12, 16, 20: Perkowski discloses a product information brokerage system, medium, method for mediating between a plurality of users and a plurality of manufacturers via an electronic network, the system comprising:

a user information storage unit for storing user attribute information and user-owned product information (col 2, lines 28-37);

a product information storage unit for storing product information (Fig. 1; Fig. 4a1; Fig. 4a2);

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a product information providing unit for providing users with information related to the products owned by users based on the product information (Fig. 2-1; col 2, lines 28-37; Fig 3a2; Fig. 3a1).

Perkowski further discloses that product information can be pre-stored product information provided by the plurality of manufacturers (Fig. 1; Fig. 4a1; Fig. 4a2).

Perkowski further discloses communication between a user and manufacturer after purchase (col 2, lines 28-37; col 2, lines 40-45) and targeting a user based upon user purchasing activity (col 33, lines 25-31) and that the user and consumer can communicate (Fig. 1; Fig. 2).

Perkowski further discloses that manufacturer can access a consumer-product database for advertising purposes (col 5, lines 9-25).

Perkowski does not explicitly disclose

a user information providing unit for providing user information to manufacturers of the products owned by users based on the user attribute information and user-owned product information.

However, Gardenswartz discloses a user information providing unit for providing user information to advertisers of the products owned by users based on the user attribute information and user-owned product information (Fig. 1; Fig. 2a; Fig. 2b; Fig. 5).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gardenswartz's providing of user and user owned product information to Perkowski's providing of user services, profiling a user, and providing a user product information after a user makes a purchase. One would have been motivated to do this in order to provide better profiling for better service providing to a user who has made a purchase.

Gardenswartz further discloses a user information registration unit that requests user attribute information only when necessary (col 11, lines 35-65).

Claim 3, 8, 13, 17: Perkowski and Gardenswartz disclose the product information brokerage system, method, means as claimed in claim 1.

Perkowski does not explicitly disclose a repair information brokerage unit that provides a manufacturer with a user request for repair of a user-owned product based on the product information storage unit.

However, Perkowski discloses a repair information brokerage unit that provides a user with manufacturer with provided repair service information to a user (col 101, lines 10-26) and that a manufacturer can provide product support and service (Fig. 2c).

Perkowski further discloses communication between a user and manufacturer after purchase (col 2, lines 28-37; col 2, lines 40-45) and that a user can make a request for services (col 99, lines 2-14).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Perkowski's users can make a request for product repair service based upon product information. One would have been motivated to do this in order to provide a convenient way for the request after purchase servicing.

Claim 4: Perkowski and Gardenswartz disclose the product information brokerage system as claimed in claim 1. Perkowski further discloses an advertisement brokerage unit that provides advertisements to users based on the user information storage unit in response to requests from manufacturers to supply such advertisements (col 33, lines 15-31; col 5, lines 9-25).

Claim 5, 9, 14, 18: Perkowski and Gardenswartz disclose the product information brokerage system, method as claimed in claim 1. Perkowski further discloses:

a information storage unit for storing information linked to the product information; and
a information selection unit for selecting information related to the user- owned products from the information stored in the information storage unit (col 101, lines 10-32).

Perkowski does not explicitly discloses that the product information includes parts information for the product.

However, Perkowski discloses repair information, complementary product information, warranty information, product description, product manual information, product updates (col 101, lines 10-32). Additionally, it is obvious that a product manual can contain product parts information.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add parts information to Perkowski's product information that can be provided. One would have been motivated to do this in order to provide further information that can be useful to a user.

Claim 6, 10, 15, 19: Perkowski and Gardenswartz disclose the product information brokerage system, method as claimed in claim 1. Perkowski further discloses a product information selection unit for selecting information about products of a same category as the products owned by the users from the product information stored in the product information storage unit (col 33, lines 25-31; col 4, line 55-col 5, line 2).

Claim 7: Perkowski and Gardenswartz disclose the product information brokerage system as claimed in claim 1. Perkowski further discloses:

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an after-sale service information storage unit for storing after-sale service information; and an after-sale service information selection unit for selecting after-sale service information of a plurality of manufacturers related to products of a same category from the after-sale service information storage unit (col 2, lines 28-37; col 33, lines 20-35; col 33, lines 25-31; col 4, line 55-col 5, line 2).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Rogers (5,978,774) discloses providing after purchase product information;
- b. Perkowski (6,064,979) discloses providing after purchase product information;
- c. Perkowski (5,950,173) discloses providing after purchase product information;
- d. Burdick (5,625,816) discloses providing after purchase product information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

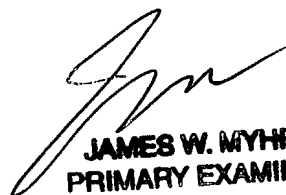
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



6/16/04



JAMES W. MYHRE
PRIMARY EXAMINER